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OFFICE OF PETITIONS

In re Application of :
VanFleet et al. :
Application No. 10/825,971 : ON PETITION
Filed: 16 April, 2004 :
Atty Dckt No. 020375-050000US :

This is a decision on the petitions filed on 17 June, 2005, under 37 CFR 1.47(a) and 1.48(a)(1) which is being treated as (a) a petition under 37 CFR 1.48(a)(1) requesting that a person be added as inventor and (b) a petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.63 and 1.67, which require that a named inventor execute a supplemental declaration.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. **FAILURE TO TIMELY RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** The reconsideration request should include a cover letter entitled "Renewed Petitions Under 37 CFR 1.48, and 1.183."

On 16 April, 2004, the above-identified application was filed without an executed declaration. On 30 August, 2004, a declaration under 37 CFR 1.63 was filed naming Steven VanFleet, John J. Mascavage, Margaret Weichert, Matthew T. Byrne, Diane Wing, and Cassandra J. Mollett as joint inventors.

On 17 June, 2005, petitions were filed, whereby petitioners seek to add Blake Benton, Timothy Horton, Susan M. Nelson, SuZanne Rogers, Rhonda D. Sargent, Martin Stivers, and Gary J. Trainor as joint inventors. Petitioners concurrently filed a petition stating that joint inventor Mascavage cannot be located to sign the declaration naming the actual inventors as required by 37 CFR 1.48(a)(3).

Petition Under 37 CFR 1.48(a)

37 CFR 1.48(a) requires that an amendment to the named inventive entity be accompanied by:

(1) a petition including a statement from each person being added and each person being deleted as an inventor that the error occurred without deceptive intention on his or her part;

(2) an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47;

(3) the fee set forth in 37 CFR 1.17(i), and

(4) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment.

In regards to item (2), the declaration filed with the present petition is defective in that it states that the name of the fifth named inventor is "John J. Mascavage III", while the declaration signed by joint inventor Mascavage states his name as "John J. Mascavage". As such, the name of the inventor appears to be different on the supplemental declaration. If joint inventor Mascavage's name was incorrectly stated on the original declaration, a grantable petition to correct the inventor's name under 37 CFR 1.182 must be filed. If inventor Mascavage's name was misstated on the supplemental declaration, a new declaration properly stating Mascavage's name, signed by all of the signing inventors, must be filed with a renewed petition.

In regards to item (4), it is unclear whether the statement of consent of the assignee was signed by an individual with authority to sign on behalf of the assignee. The statement must be signed by an officer of the corporation (president, vice president, secretary, or treasurer). In this case, the statement was signed by Ken Algiene, Assistant Secretary. It is also noted that the statement does not state that the person signing is authorized to sign on behalf of the assignee, nor has proof of authority to sign the statement of consent been provided. Likewise, although a statement under 37 CFR 3.73(b) has been provided and states that the individual signing it is authorized to do so, the statement of consent of the assignee is not signed by a person with express or implied authority to do so. As such, a new statement of consent of the assignee, signed by a person with authority to sign on behalf of the assignee, must be provided with a renewed petition.

Petition Under 37 CFR 1.183.

Suspension of the rules under 37 CFR 1.183 may be granted in an "extraordinary situation, when justice requires." The facts presented on the record do not adequately establish an extraordinary situation. Petitioner has not sufficiently established any special circumstances of equities that would require suspension of the rules in the interests of justice.

There is no requirement for a showing under 37 CFR 1.47, as noted above. This application bears an original Declaration executed by joint inventor Mascavage, and thus, the provisions of 37 CFR 1.47 do not apply in this instance. Nevertheless, it is appropriate to apply the principles thereof to the situation at hand.

As stated above, the supplemental declaration is defective in that it states a different name for joint inventor Mascavage than was stated on the original declaration executed by the joint inventor. A new oath or declaration and/or a petition under 37 CFR 1.182 to correct the inventor's name, if appropriate, must be filed.

Additionally, in the event that the application papers are returned as undeliverable, petitioners may show diligent efforts to locate the non-signing inventor by providing a copy of an envelope showing that a letter sent to the last known address of the non-signing inventor was returned as undeliverable by the post office. Details of the efforts made to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person having first-hand knowledge of the details. Additionally, if any inventor no longer lives at the last known address, petitioners may show diligent efforts by use of e-mail, internet, or telephone searches to determine a current address for the non-signing inventor. If a more recent address is discovered, petitioners should send or give a copy of the application papers to the inventor at that address.

If repeated attempts to contact the non-signing inventor are unsuccessful, petitioners will have shown that despite diligent efforts, the inventor could not be reached.

Petitioners should show that efforts were made to locate a more current address for joint inventor Mascavage.

A copy of the declaration, as indicated above, should be sent to the non-signing inventor for review and with instructions that

the non-signing inventor sign and return the declaration. A copy of the cover letter transmitting the application papers to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first hand knowledge of the details.

Petitioners should provide proof that the inventor refuses to sign the declaration after receiving the application papers. If there is a written refusal, petitioner should submit a copy of the written refusal. If the refusal is made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

Additionally, as the present petition requires treatment under 37 CFR 1.183 rather than 1.47, a petition fee of \$400.00 pursuant to 37 CFR 1.17(f) is due. Counsel's deposit account, No. 20-1430, will be charged the additional \$200.00 for the petition under 37 CFR 1.183 as authorized on the fee transmittal form filed on 30 August, 2004.


Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.


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